

REMARKS

Overview

In the Office Action under reply, claims 1-41, 43-47, 49-56, and 58-62 are pending, claims 42, 48, and 57 having been canceled previously. The claims have been rejected as follows:

- (1) claims 1-40 are rejected under 35 U.S.C. §112, second paragraph; and
- (2) claims 1, 2, 5-30, 36-41, 43, 44, 46, 47, 49-51, 53-56, 58, 59, 61, and 62 are rejected under the judicially created doctrine of double patenting.

In addition, claims 45, 52, and 60 are objected to as dependent upon a rejected base claim.

The rejections and objections are traversed for at least the reasons set forth below.

Rejection under 35 U.S.C. §112, second paragraph

Claims 1-40 stand rejected under 35 U.S.C. §112, second paragraph, as “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention” (Action at page 2). The Examiner states that “it is unclear from the two process steps recited how an image is formed on the substrate” (Action at page 2). This rejection is traversed.

The Examiner asks two questions on page 2 of the Action. “Is an image pre-printed on the substrate and hence revealed when the opaque coating become entirely transparent? Is the recording liquid provided in a desired pattern and only that portion of the opaque coating that comes in contact with the patterned recording liquid is rendered entirely transparent, as opposed to the entire opaque coating?” Indeed, the claims encompass both embodiments described by the Examiner.

Claim 1 requires the steps of: “... (a) applying to the surface of a reflective, glossy, and/or luminescent substrate, to form an opaque coating thereon an opaque coating composition... and (b) contacting the coated substrate with a recording liquid that renders the opaque coating partially or entirely transparent.”

Regarding the embodiment described in the Examiner’s first question, paragraph [0074] on page 17 of the specification provides guidance:

In an additional aspect of the invention the light-emitting, reflective or metallic-looking image is produced by having the image or color scheme printed on the reflective or luminescent layer prior to the coating with the opaque coating composition. The light-emitting, reflective or metallic-looking image is generated by contacting the coated substrate with an aqueous solution that may optionally contain a dye or colorant, as discussed above. Embodiments of this type have utility as art or craft materials. The coated substrates of the invention may be used as "magic" papers and the like for children, wherein a hidden image appears on contact with a solution. (Emphasis added.)

The Examiner's attention is also drawn to paragraph [0016] on page 3 of the specification, which describes the embodiment wherein "a substrate is provided having a surface selected from the group consisting of reflective surfaces, glossy surfaces, and luminescent surfaces, having a preselected image or color scheme on the surface and additionally coated with an opaque coating composition that becomes transparent upon contact with a recording liquid." Clearly, therefore, the embodiment described in the Examiner's first question is within the scope of the disclosure and the claims.

Regarding the Embodiment described in the Examiner's second question, this embodiment is also encompassed by claim 1. It would be immediately apparent to the skilled artisan that the steps described in the claim allow the preparation of an image according to the process described by the Examiner. By applying an opaque coating to the surface of a reflective, glossy, and/or luminescent substrate, as described in step (a) of claim 1, the reflective, glossy, and/or luminescent substrate surface is masked behind the opaque coating. The reflective, glossy, and/or luminescent substrate is then revealed (in whole or in part) by rendering the opaque coating partially or entirely transparent. By rendering the opaque coating transparent in some areas of the substrate but not in others, the surface of a reflective, glossy, and/or luminescent substrate becomes visible in selected areas of the substrate while the opaque coating masks the remaining areas of the substrate. Clearly, such a procedure can be used to form a pattern (e.g., a pattern comprising reflective, glossy, and/or luminescent areas juxtaposed with opaque areas).

The Examiner has characterized two embodiments encompassed by the claims. Applicants submit that the claims are therefore clearly described and supported, and applicants respectfully request withdrawal of the rejection.

Obviousness-Type Double Patenting Rejection

Claims 1, 2, 5-30, 36-41, 43, 44, 46, 47, 49-51, 53-56, 58, 59, 61, and 62 stand rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1, 3-18, 29-37, 39-44, 46-49, and 51 of U.S. Patent No. 6,241,787. Without conceding the validity of the rejection, but for the sole purpose of expediting prosecution, applicants are filing a Terminal Disclaimer over the abovementioned U.S. Patent. The Terminal Disclaimer meets all requirements of 37 C.F.R. §1.321(b), and, accordingly, applicants respectfully request withdrawal of the rejection.

CONCLUSION

Applicants submit that the claims of the application are in condition for allowance. Applicants respectfully request withdrawal of the rejections, and prompt issuance of a notice of allowance. If the Examiner has any questions concerning this communication, or would like to discuss the application, the art, or other pertinent matters, a telephone call to the undersigned would be welcomed.

Respectfully submitted,

By:


Isaac M. Rutenberg
Registration No. 57,419
c/o MINTZ LEVIN
1400 Page Mill Road
Palo Alto, California 94304-1124
(650) 251-7700 Telephone
(650) 251-7739 Facsimile
Customer Number 23980